

REMARKS

In response to the Office Action dated May 5, 2004, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-34 were rejected under 35 U.S.C. § 101 as allegedly being drawn to non-statutory subject matter. Claims 1-34 have been canceled to expedite prosecution. This rejection is rendered moot by the cancellation of claims 1-34.

The Office Action rejected claims 1-52 under 35 U.S.C. § 103(a) as being unpatentable over www.Rogers.com, "Portage™ Wireless Connectivity, Quick Start Guide, 10-2000" ("Rogers"). The rejection of claims 1-34 is rendered moot by the cancellation of these claims. This rejection of claims 35-52 is traversed for the following reasons.

Rogers teaches using a mobile phone to connect a mobile computer to a network and synchronizing a remote computer (e.g., a user's desktop) with the mobile computer. Thus, Rogers does teach instructions for transferring software to the mobile computer. Rogers fails to teach instructions for "connecting the mobile computer to the telecommunications equipment, accessing the software program downloaded onto the mobile computer, and transferring the software program from the mobile computer to the telecommunications equipment" and the subsequent implementation of these instructions as recited in claim 35.

The Examiner states that the mobile computing device includes the necessary adapters/connectors to perform such a transfer to communication equipment and concludes that "it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include instructions for guiding a particular service such as connecting telecommunications equipment to an output of a mobile computer." The rationale is that "doing so would conform to a common standard of a web service which provides online instructions and downloaded software, thereby it allows a person doing connection by following the instruction in its website without using a manual."

Applicants respectfully disagree that there is any teaching or suggestion in Rogers to transfer software from the mobile computer to telecommunications equipment. The fact that the mobile computer in Rogers includes suitable adapters and connectors does not lead to the conclusion that downloaded software should be transferred to telecommunications

equipment. This rationale resounds of an "obvious to try" analysis which is an improper standard for obviousness. A finding of "obvious to try" does not provide the proper showing for an obviousness determination. The requirement for a determination of obviousness is that "both the suggestion and the expectation of success must be founded in the prior art, not in applicant's disclosure" (emphasis added). *In re Dow Chem.*, 837 F.2d 469, 473, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). An Examiner, then, cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do.

In the present case, there is no suggestion in Rogers to provide instructions to transfer software from the mobile computer to telecommunications device. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2143.01. There is no teaching in Rogers to transfer software to telecommunications equipment as recited in claim 35.

For the above reasons, claim 35 is patentable over Rogers. Claims 36-50 depend from claim 35 and are patentable over Rogers for at least the reasons advanced with respect to claim 35. Claims 51-52 include features similar to those discussed above with respect to claim 35 and are patentable over Rogers for at least the reasons advanced with respect to claim 35.

For all the reasons advanced above, it is respectfully submitted that the application is in condition for allowance. Accordingly, reconsideration and allowance of the claims are respectfully requested. The Examiner is cordially requested to telephone, if the Examiner believes that it would be advantageous to the disposition of this case.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment, which may be required for this amendment, to Deposit Account No. 06-1130. In the event that an extension of time is required, or may be required in addition to that requested in any petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby

authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 06-1130.

Respectfully submitted,

By: 

David A. Fox
Registration No. 38,807
CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield, CT 06002
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 36192

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